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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,699	05/25/2006	Shin Masaoka	1217-061625	5404

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EXAMINER

NWAONICHA, CHUKWUMA O

ART UNIT	PAPER NUMBER
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1621

MAIL DATE	DELIVERY MODE
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07/14/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/580,699	Applicant(s) MASAOKA ET AL.	
	Examiner CHUKWUMA O. NWAONICHA	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>14 May 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 14 May 2009 has been entered.

Current Status

1. Claims 1-6 are pending in the application.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith et al., {Phosphorus mustards. 1-3 III. Bis(2-chloroethyl)methylphosphine oxide and bis(2-

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benzoxyethyl)methylphosphine, JOURNAL OF MEDICINAL CHEMISTRY, 11(5), 1060-3}.

Smith et al. disclose applicant's claimed process for producing phosphonium borate compound (tri-*n*-butylphosphonium tetraphenylborate). See page 1063, column 2; paragraph 5.

Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Ayllon et al., {Proton Transfer I-3 in Aminocyclopentadienyl Ruthenium Hydride Complexes, ORGANOMETALLICS , 18(20), 3981-3990}.

Ayllon et al. disclose applicant's claimed process for producing phosphonium borate compound (tri-*n*-butylphosphonium tetraphenylborate). See page 3989, column 1; paragraph 3.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al., {Phosphorus mustards. 1-3 III. Bis(2-chloroethyl)methylphosphine oxide and bis(2-benzoxylethyl)methylphosphine, JOURNAL OF MEDICINAL CHEMISTRY, 11(5), 1060-3} or Ayllon et al., {Proton Transfer I-3 in Aminocyclopentadienyl Ruthenium Hydride Complexes, ORGANOMETALLICS , 18(20), 3981-3990}.

Applicants claim a process for producing phosphonium borate compound; wherein all the variables are as defined in the claims;

Determination of the scope and content of the prior art (M.P.E.P. §2141.01)

Smith et al. teach applicant's claimed process for producing phosphonium borate compound (tri-*n*-butylphosphonium tetraphenylborate). See page 1063, column 2; paragraph 5.

Ayllon et al. teach applicant's claimed process for producing phosphonium borate compound (tri-*n*-butylphosphonium tetraphenylborate). See page 3989, column 1; paragraph 3.

Ascertainment of the difference between the prior art and the claims (M.P.E.P. §2141.02)

Smith et al. and Ayllon et al. process for producing phosphonium borate compound differs from the instant claims in that Applicants claim a process that employ HCl and H₂SO₄ as reagents while Smith et al. and Ayllon et al. teach a process that employed HCl as a reagent.

Finding of prima facie obviousness--rational and motivation (M.P.E.P.. §2142-2143)

The instantly claimed process for producing phosphonium borate compound would have been obvious to one of ordinary skill in view of the process taught by Smith et al. and Ayllon et al. because the references cited teach the use of inorganic acid.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by correlating the teachings of the references cited by evaluating different commercially available inorganic acids to prepare phosphonium borate compounds as desired. Said person would have been motivated to practice the teachings of the references cited because the references demonstrated the use of the phosphonium borate compounds in industrial applications. The instantly claimed invention would therefore have been obvious to one of ordinary skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne (Bonnie) Eyler can be reached on 571-272-0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chukwuma O. Nwaonicha/
Examiner, Art Unit 1621

(for)

/Sikarl A. Witherspoon/
Primary Examiner, Art Unit 1621

Daniel Sullivan
Supervisory Patent Examiner,
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